



07 NOV 2007

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

WHITE & CASE LLP
PATENT DEPARTMENT
1155 AVENUE OF THE AMERICAS
NEW YORK NY 10036

In re Application of TSELNER et al. :
Application No.: 10/581,373 : DECISION ON
PCT No.: PCT/DE04/02623 :
Int. Filing: 26 November 2004 : PETITION
Priority Date: 03 December 2003 :
Attorney Docket No.: 6169555-0004 : UNDER 37 CFR 1.47(a)
For: FRESH CONCRETE AND ADMIXTURE :
FOR FRESH CONCRETE :

This is a decision on applicant's petition under 37 CFR 1.47(a), filed in the United States Patent and Trademark Office (USPTO) on 31 August 2007, to accept the application without the signature of the heir of joint inventor, Mikhail Tselner. Petitioner requests a five month extension of time, which is granted.

BACKGROUND

On 02 June 2006, applicant filed a transmittal letter (PTO-1390) requesting entry into the national stage in the United States of America under 35 U.S.C. § 371. Filed with the Transmittal Letter was, *inter alia*, the requisite basic national fee.

On 29 January 2007, a Notification of Missing Requirements (FORM PCT/DO/EO/905) was mailed to applicant indicating *inter alia*, that an oath or declaration, in accordance with 37 CFR 1.497(a) and (b), and the English translation of the international application as filed along with the surcharge for filing the oath or declaration and the processing fee for filing the English translation after the thirty month period, was required. The notice set a two (2) month time period within which to reply. Extensions of time under 35 CFR 1.136(a) were available.

On 31 August 2007, applicant filed the instant petition along with a declaration, executed by the joint inventor on behalf of the nonsigning inventor. The petition under 37 CFR 1.47(a) in an attempt to satisfy the requirements of 35 U.S.C. 371(c)(4) requested the acceptance of the application without the signature of the heir of joint inventor Mikhail Tselner, alleging that Mr. Tselner's heir refuses to sign the application.

DISCUSSION

A petition under 37 CFR §1.47(a) must be accompanied by (1) the fee under 37 CFR §1.17(g), (2) factual proof that the non-signing joint inventor(s) refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the non-signing inventor(s), and (4) an oath or declaration by each available joint inventor on his or her own behalf and on behalf of the non-signing joint inventor(s).

Petitioner satisfied Items (1), (3) and (4).

With respect to Item (2) above, Petitioner has provided copies of emails with the German law firm involved with the application. According to counsel's petition, on 26 July 2007, the German law firm sent a declaration by facsimile to Mrs. Tselner. According to the petition, the declaration was also mailed to Mrs. Tselner. However, a statement by the person having first hand knowledge of the facts surrounding the presentation of the papers to the deceased inventor's heir has not been provided and is required. Petitioner has not provided any evidence that a complete copy of the application papers was presented to the heir(s) of the deceased inventor and that the heir(s) refused to sign the application

Section 409.03(d) of the Manual of Patent Examining Procedure (MPEP), Proof of Unavailability or Refusal, states, in pertinent part:

A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney.... It is reasonable to require that the inventor be presented with the application papers before a petition under 37 CFR 1.47 is granted since such a procedure ensures that the inventor is apprised of the application to which the oath or declaration is directed. In re Gray, 115 USPQ 80 (Comm'r Pat. 1956)

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Proof that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature, but the inventor refused to accept delivery of the papers or expressly stated that the application papers should not be sent, may be sufficient. When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the statement of facts. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the statement of facts. The document may be redacted to remove material not related to the inventor's reasons for refusal.

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which the conclusion is based should be stated in a statement of facts in support of the petition or directly in the petition. If there is documentary evidence to support facts alleged in the petition or any statement of facts, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the petition.

(Emphasis added.)

Applicant is advised that the declaration must be in compliance with 37 CFR 1.497(a) and (b). The declaration must be executed by all the heirs of deceased inventor. If there is a sole heir, the declaration should indicate such. The declaration must identify both the deceased inventor and the sole heir and must state country of citizenship, former residency and mailing address for *both* the deceased inventor and the heir, for compliance with 37 CFR 1.497(b).

In sum, Petitioner has satisfied Items (1), (3) and (4) above. However, Petitioner has not

satisfied Item (2) by demonstrating: (1) a *bona fide* attempt was made to present a *copy of the application papers for U.S. application 10/581,373 (specification, including claims, drawings, and declaration)* to the nonsigning heir(s) of the deceased inventor for his signature and (2) nonsigning heir's refusal to sign, either in writing or by telephone, these documents.

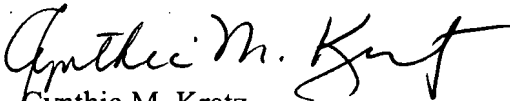
For the reasons set forth above, the evidence submitted does not support a finding that the nonsigning inventor refuses to sign the application at this time. Accordingly, it is inappropriate to accord the national stage application status under 37 CFR §1.47(a) at this time.

CONCLUSION

The petition under 37 CFR §1.47(a) is **DISMISSED WITHOUT PREJUDICE**.

Any reconsideration on the merits of the petition under 37 CFR §1.47(a) must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR §1.47(a)." No petition fee is required. Any further extensions of time available may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



Cynthia M. Kratz
Attorney Advisor
PCT Legal Office
Office of PCT Legal Administration

Telephone: (571) 272-3286
Facsimile (571) 272-0459